IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of)	
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Waesterlid)	
)	
Serial No. 09/514,657)	D Agosta, Stephen M.
)	Examiner
Filed: February 29, 2000)	Group Art Unit 2684
)	
For: **METHOD FOR FACILITATING**)	
ELECTRONIC COMMUNICATIONS)	
)	
Attorney's Docket No. 4015-321)	

Raleigh, North Carolina

April 17, 2003

Box AF
Commissioner for Patents
Washington, D.C. 20231

Appeal Brief

The present appeal brief is filed in triplicate pursuant to 37 C.F.R. §1.192.

Enclosed is a check in the amount of $320.00 as required under 37 C.F.R. §1.17(c). If

any additional fees are due or required, Applicant requests that this be considered a

Petition therefore, and the Commissioner is hereby authorized to charge Deposit

Account 18-1167.

(1) REAL PARTY IN INTEREST

The real party in interest is Ericsson, Inc., Assignee of the present invention.

(2) RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences to the best of Applicant's

knowledge.

(3) STATUS OF CLAIMS

A total of 25 claims have been presented for examination. Claim 9 was cancelled during prosecution leaving claims 1-8 and 10-25 pending. The Examiner has finally rejected claims 1-8 and 10-25, and as such, Applicant appeals the rejection of claims 1-8 and 10-25.

(4) STATUS OF AMENDMENTS

Applicant believes that all amendments have been entered. This is contrary to the Examiner's indication in the Advisory Action dated February 10, 2003. Claims 1, 4, 7-8, 10, 13, 16-17, 19, 22-23, and 25 were amended in response to the first Office Action dated September 24, 2002, however, Applicant did not amend any claims after the issuance of the Final Office Action dated November 19, 2002. As such, Applicant assumes the Examiner's indication to be a minor typographical error, and that all amendments have been entered.

(5) SUMMARY OF INVENTION

Applicant's claimed invention facilitates electronic communications between individuals sharing a common interest or affiliation (an "affinity" group), by providing a method and apparatus in which each member of the affinity group may send/receive status updates to/from each of the other members of the affinity group (*see* spec., p.2 ¶3). Hence, when any member undergoes a change in status, each of the other members of the affinity group receives the status update, and stores the status update in a personal communications device (*see* spec., p.2 ¶4 – p.3 ¶1) That way, one member of the affinity group can readily access the status of the other members of the affinity group at his/her personal communications device without having to request the information from the network each time (*see* spec., p.2 ¶3; p.3 ¶3). Note that the

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claimed status update methods are reciprocal (i.e., multidirectional updates), not "master-slave" type methods. That is, the transmission and receipt of status updates are not strictly limited to unidirectional communications from a single "master" to one or more "slaves," but instead the communication of status updates occurs bilaterally between all members of the affinity group, allowing each member of the group to track the status of any other member in the group (*see* spec., p.10 ¶4 – p.11 ¶1).

(6) ISSUES

Whether claims 1-8 and 10-25 are obvious under 35 U.S.C. §103(a) over WO 98/17032 to Borgstahl et. al. (hereinafter "Borgstahl") in view of the IETF Internet Draft entitled "SIP for Presence" to Rosenberg et. al. (hereinafter "Rosenberg").

(7) GROUPING OF CLAIMS

The claims should be grouped as follows:

Group 1: Claims 1, 7, and 8.

Group 2: Claims 2, 3, 11, and 12.

Group 3: Claims 4 and 13.

Group 4: Claims 5 and 14.

Group 5: Claims 6 and 15.

Group 6: Claims 10, 16, 17, and 18.

Group 7: Claims 19 and 25.

Group 8: Claims 20 and 21.

Group 9: Claim 22.

Group 10: Claim 23.

Group 11: Claim 24.

All claims in each group stand or fall together.

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(8) ARGUMENT

A. The Law of Obviousness

The PTO has the burden under § 103 to establish a *prima facie* case of obviousness. In order to establish a *prima facie* case under §103, the Examiner must show 1) some suggestion or motivation to modify the modify the primary reference or to combine the teachings of the references; 2) a reasonable expectation of success; and 3) that the prior art reference (or references, when combined) teach or suggest all the claim limitations. *E.g., In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974); MPEP §2143. Further, it must be noted that if an independent claim is nonobvious under §103, then any claim depending therefrom is nonobvious. *E.g., In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); MPEP §2143.03.

When combining references, the PTO can satisfy this burden only by showing some objective teaching in the prior art, or knowledge generally available to one of ordinary skill in the art, that would motivate one to combine the relevant teachings of the references. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

Whether or not a teaching, motivation, or suggestion exists that would lead one skilled in the art to select and combine references is central to the question of patentability with respect to obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002). Simply combining elements in a manner that reconstructs the applicant's invention only with the benefit of hindsight is insufficient with which to establish a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art that would lead a person of ordinary skill in the field of the invention to

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make the combination. That knowledge cannot come from the applicant's invention itself. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). Therefore, in advancing a motivation to combine references, the Examiner must adequately address the issue of motivation to combine, specifically pointing out the reasoning supporting such a combination, and basing the reasoning on concrete evidence of record. *In re Lee, supra.*

B. The Examiner has failed to make out a *prima facie* case of obviousness.

The Examiner rejected claims 1-8 and 10-25 under 35 U.S.C. §103(a) over Borgstahl in view of Rosenberg. The primary reference, Borgstahl, discloses the dynamic creation of a peer-to-peer network in which electronic devices transmit/receive data based upon the needs and capabilities of the devices (i.e., peers). According to Borgstahl, one peer may establish a link with another peer when the two are in close geographical proximity to one another. The peers then perform a query-response session to exchange their needs and capabilities. If the needs of one peer match the capabilities of the other peer, the two devices exchange data; otherwise, the link is abandoned.

The second reference, Rosenberg, discloses a protocol (i.e., a modified Session Initiation Protocol) that facilitates communication between a publisher (i.e., a user) and a subscriber (i.e., another user). In Rosenberg, a subscriber may be notified about events regarding the publisher in one of two ways. First, the subscriber may poll the publisher manually. Second, the subscriber can configure a "trigger" regarding a specific event with respect to the publisher. This is referred to in Rosenberg as "subscribing" to the publisher. Whenever the particular event occurs, or is "triggered," the publisher notifies the subscriber via a modified SIP message. An example of a trigger disclosed by Rosenberg is, "notify me when event X in state machine Y occurs if the day is Tuesday

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and the temperature in Zimbabwe is 85 degrees Fahrenheit" (*See* Rosenberg, page 1, Introduction). Typically, the messages are first sent from the publisher to a central server before being transmitted to the subscriber.

Group 1

Claim 1, the independent claim of Group 1, relates to a method implemented in a communications network that permits each member of an affinity group to send/receive status information to/from each of the other members in the affinity group. For reference, claim 1 appears below.

> 1. A communication method implemented in a communication network for allowing members of an affinity group to send status information to and receive status information from other members of said affinity group, said communication method comprising:
> a. forming an affinity group containing two or more members;
> b. storing, in each individual members' communication device, status information concerning each other member of said affinity group;
> c. when the status of any member in said affinity group changes, sending a status update message from said member whose status has changed to said each other member of said affinity group;
> d. receiving said status update messages concerning each other member of said affinity group at said each other member's communication device; and
> e. updating said status information in said each other member's communication device when a status update message concerning said any member is received.

Claim 1 requires that each member of the affinity group have a communications device in which the status information of each other member in the group is stored. When the status of <u>any</u> member in the affinity group changes, a status update message is sent to <u>each other member</u> in the affinity group. Upon reception of the status message, the status information of the member whose status has changed is then updated in <u>each other members'</u> communication device. Thus, claim 1 requires the reciprocity of status update messages between each member of the affinity group.

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The §103 rejection of claim 1 is improper because there is no legally proper motivation to combine Borgstahl and Rosenberg and, even if they are combined, the combination fails to teach at least two limitations of independent claim 1.

First, neither Borgstahl nor Rosenberg teach or suggest, alone or in combination, "when the status of any member in said affinity group changes, sending a status update message from said member whose status has changed to said each other member of said affinity group." The Examiner admits on page 3 of the Final Office Action that Borgstahl fails to teach this requisite element, but asserts that Rosenberg does[1].

To support the rejection, the Examiner contends that both the peer-to-peer networks of Borgstahl and the TDMA/CDMA/FDMA networks of Rosenberg teach "full-duplex" communications between endpoints. However, this contention incorrectly equates full-duplex communications with the reciprocity of the communication of status information between each of the affinity group members. Full-duplex communications simply means that two users, for example users A and B, can communicate with one another. It says nothing about the ability of one affinity group member to send a status update message to each other member of the affinity group when his/her status changes. That is, merely because users A and B can converse in a full-duplex mode does not mean that users A and B are updated whenever each others' status changes. Indeed, the subscriber in Rosenberg will only receive status updates with respect to the particular publisher to whom the subscriber has subscribed, but will not receive status updates concerning any of the other members in the group. This is very clear from Figure 1 on page 3 of Rosenberg, as each of the arrows denoting communications paths emanates from the publisher. Importantly, however, Figure 1 is conspicuously devoid of

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[1] Although the Examiner admits that Borgstahl fails to teach this element, the Examiner does rely on both Borgstahl and Rosenberg to refute Applicant's arguments with respect to the reciprocity of communications required by this element (*see* p.2, ll. 5-14 of the Final Office Action; *see also* p.2, ll. 1-5 of the Advisory Action). As such, the following remarks address both the Borgstahl and Rosenberg references.

any communication paths terminating with the publisher (i.e., from the subscriber to the publisher). Even more evidence of this fact appears on page 17 of Rosenberg, section 11, paragraph 2, in which Rosenberg reveals, "A NOTIFY method is an FYI – its propagated by the server to the subscribers. In most cases, the publisher won't even know who the subscribers are" (emphasis added). How can the Rosenberg reference teach or even suggest the reciprocity of status update messages between each of the affinity group members if the publisher in Rosenberg is unaware of any of the other members in the group? The answer is, it cannot.

In Rosenberg, subscriber B receives status updates from publisher A; however, publisher A is completely ignorant of any change in the status of subscriber B. All status updates occur only from the publisher to the subscriber, never the other way around (i.e., the status updates are not reciprocated from the subscriber to the publisher). The failure to reciprocate the status changes becomes even more evident upon extending the concept of Rosenberg to a group consisting of three members, subscribers B and C who subscribe to a publisher A. In this scenario, subscribers B and C only receive status updates from publisher A. However, subscribers B and C are completely ignorant of each other's status, and publisher A is equally as ignorant of the status of both B and C, even though they belong to the same group. Contrast this to Applicant's claimed method which requires notifying A of the status changes for both B and C; notifying B of the status changes for both A and C; and notifying C of the status changes for both A and B.

In short, full-duplex communications are not required by claim 1, but reciprocity is, and neither reference teaches or suggests this element. As neither Borgstahl nor Rosenberg teach or suggest the reciprocity of communicating status updates between each of the group members, it necessarily follows that the combination of Borgstahl and

Rosenberg also fail to teach or suggest the reciprocity of communicating status updates between each of the group members.

Second, both Borgstahl and Rosenberg fail to teach or suggest, alone or in combination, the claimed "storing, in each individual members' communication device, status information concerning each other member of said affinity group." The Examiner never asserts that Rosenberg teaches this requisite element, but *theorizes* that the memory disclosed in Borgstahl would be used to store the status of each of the other affinity group members (*see* Advisory Action p.2, I.5; *see also* Final Office Action, p.3, claim 1). However, this observation is wholly unsupported by the Borgstahl reference. A close reading of Borgstahl reveals that the disclosed memory (reference #42 in Fig. 2) stores executable programs, personalization data, and application data (i.e., data used by the applications). Borgstahl teaches that the personalization data are ID codes, passwords, PINs, radio or TV channel presets, language preferences, and speed dial telephone numbers, while the application data are facsimile numbers, scanned data (e.g., using a bar code reader), telephone numbers received via pager, and sound snippets (*see* Borgstahl, p. 7, line 32 – p. 8, line 7). Plainly, none of the data stored in the memory of Borgstahl has anything to do with the status information of the member that owns the device, let alone the status information of other group members.

The Examiner's *assumption* that the disclosed memory can be used to store the status of each of the other affinity group members is incorrect as a matter of law. The Patent Office has the burden of proving a *prima facie* case of obviousness, and that includes a showing that each element is taught by the reference or references of record. The Borgstahl patent, however, is conspicuously devoid of any evidence whatsoever that supports this theory. Specifically, Borgstahl _never_ teaches or suggests using the disclosed memory to store status information of any of the users. Simply because the Examiner believes that the memory of Borgstahl *might theoretically* be used to store

status information does not mean that it does, nor does it mean that the cited art teaches that use.

The fact that both references cited by the Examiner fail to teach each of the claimed elements is enough to require withdrawing the §103 rejection. However, assuming *arguendo* that each of the claim 1 elements is shown by the cited art (which they are not), the §103 rejection still fails for a third reason. In particular, the Examiner has failed to put forth a *legally sufficient* motivation to combine. The law requires the Examiner to specifically point out the rationale behind the combination, and further, base the rationale on concrete evidence of record.

> The examiner's conclusory statements that …do not adequately address the issue of motivation to combine. This factual question of motivation is <u>material to patentability</u>, and could not be resolved on <u>subjective belief and unknown authority</u>…Thus, the Board must not only assure that the requisite findings are made, based on <u>evidence of record</u>, but must also <u>explain the reasoning by which the findings are deemed to support the agency's conclusion</u>.

In re Lee, 61 U.S.P.Q. 2d 1430,1434 (Fed. Cir. 2002) (emphasis added). Further, there must be some reason, suggestion, or motivation found in the prior art that would lead a person of ordinary skill in the field of the invention to make the combination. That knowledge cannot come from the applicant's invention itself. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992).

The Examiner states in the Final Office Action that it would have been obvious to modify Borgstahl "such that an affinity group is used and a status update message is sent when changed, to provide each wireless member with up-to-date information about the network for ease of use." Such a motivation, however, simply fails scrutiny.

The Examiner defines the problem to be solved as providing the users with up-to-date information about the network for ease of use. However, the solution (motivation) postulated by the Examiner does not solve his stated problem. Providing status updates

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about the *users* does not provide up-to-date information about the *network*; instead, it only supplies up-to-date information about the <u>users</u>. For instance, the network may be experiencing huge problems in one area, or have a particular function completely disabled, but telling a member of an affinity group about the status change of another member of the affinity group tells the members absolutely nothing about the network's problems. Simply put, even assuming *arguendo* that the Examiner's postulation about the need for network updates is true, the solution -- providing status updates about affinity members' status changes -- does not address the stated need. Nor does it provide any actual basis for combining the references. Under scrutiny, it appears that that the proffered motivation is based on nothing more than speculation and unsupported facts, and is instead nothing more than an attempt to paper over impermissible hindsight reconstruction.

In short, the conclusory statement offered by the Examiner with respect to Borgstahl and Rosenberg is woefully inadequate with respect to addressing the issue of motivation to combine, as it is inaccurate and unsupported by any evidence of record. Simply stating a reason to combine, especially one that is inaccurate and based on Applicant's own disclosure, is not now, nor has it ever been, a *legally sufficient* motivation to combine. Accordingly, the §103 rejection with respect to claim 1 is improper.

Group 2

Claim 2, a Group 2 claim, depends directly from claim 1 and further defines that the status information reported to each other member in the affinity group be comprised of a plurality of items. For reference, claim 2 appears below.

> 2. The communication method according to claim 1 wherein said status information comprises a plurality of status items.

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Page 8 of the specification, lines 15-21 provide some exemplary status items reported to each member of the affinity group in one embodiment of the invention. These include the current state of the member's device, the member's current activity (e.g. at work, at a meeting, at lunch), and the member's current location.

For the reasons stated above, neither reference teaches or suggests, alone or in combination, claim 1. Accordingly, neither reference can teach or suggest, alone or in combination, its dependent claim 2. Thus, the §103 rejection of claim 2 is improper.

Further, the Examiner asserts in his rejection that Borgstahl teaches status information that comprises a plurality of status items, and cites Figures 3-5, 7 and page 10, lines 30-35 of Borgstahl to support the rejection. However, the Examiner's contention is incorrect. In stark contrast, Figures 3-5 do not disclose a plurality of status items as required by claim 2, but instead, illustrate possible hardware devices that may be used as peers (*see Borgstahl* p.8, line 20 – p.9, line 11). Moreover, a close reading reveals that the cited passage does not teach that status information comprises a plurality of status items, but rather teaches the format of a need/capability message broadcast to the peer. Particularly, the message may include a peer ID, an authorization key, a needs specification, and a capability specification (*see also* Figure 7 of Borgstahl). The needs and capabilities disclosed by Borgstahl are readily apparent from the table illustrated in Figures 8 and 9, respectively. None of the entries in either table teaches or even suggests the status information required by Applicant's claims.

While the Patent Office must give the claims their broadest reasonable meaning, it cannot ignore the "reasonableness" directive, and it certainly cannot ignore Applicant's specification. The terms and phrases of a claim must be construed in harmony with the Applicant's written description. "[The mandate of broadest reasonable interpretation during prosecution] does not relieve the PTO of its essential task of examining the entire patent disclosure to discern the meaning of claim words and phrases." *Atlantic*

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Thermoplastics Co., Inc. v. Faytex Corp., 970 F.2d 834 (Fed. Cir. 1992), *reh'g in banc denied*, 974 F.2d 1279 (Fed. Cir. 1992). In this case, the Examiner has afforded an unreasonably broad and flawed interpretation to the claim 2 phrase "status information [comprising] a plurality of status items." The format of the message of Borgstahl, regardless of its content, does not constitute the claimed status information comprising a plurality of status items, and neither does a list of hardware devices that may be used as peers. Therefore, the art cited by the Examiner fails to teach or suggest, alone or in combination, claim 2.

Group 3

Claim 4, a Group 3 claim, depends directly from claim 2, and indirectly from claim 1. For reference, claim 4 appears below.

> 4. The communication method according to claim 2 wherein each individual member selects the status items from a list of available status items that are reported to each other member of the affinity group.

Claim 4 requires that each individual group member select the status items from a list of available items. The chosen status items are the items that are reported to each other member in the group. This permits each individual member in the affinity group to control the status information made available to each of the other members in the group.

As both the Borgstahl and Rosenberg references, alone or in combination, fail to render either of claims 1 and 2 obvious, it necessarily follows that they also fail to obviate claim 4. Therefore, the §103 rejection of claim 4 is improper.

Further, the Examiner in his rejection asserts that the users of Rosenberg can receive status updates based upon a trigger, while admitting that Borgstahl fails to teach the added limitation of clam 4.. The example provided by the Examiner recites the ability of a subscriber in Rosenberg to configure a device to "notify [the subscriber] when event

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X in state machine Y occurs if the day is Tuesday and the temperature in Zimbabwe is 85 degrees Fahrenheit" (*See* Final Office Action, p.4).

While it is true that Rosenberg teaches the use of a trigger, the disclosed triggers are configured only by the subscriber (i.e., the receiving party), not each individual group member. That is, the *publisher* in Rosenberg does not specify what triggers are made available to each other member in the group; rather, the subscriber configures a trigger for a particular publisher that is "triggered" when that specific event occurs with respect to the publisher. Contrast this with claim 4, which requires <u>each</u> member of the group (not just the subscriber) to select the status items from a list of available status items that are to be reported to <u>each other member</u> of the group. When couched in terms of Rosenberg, both the publisher and the subscriber would have to select the triggers from a list of available triggers that are reported to the each other. At most, Rosenberg shows only that the subscriber configures the trigger.

These facts notwithstanding, the Examiner opines that in view of the Rosenberg reference (and more specifically, the above-cited example), one skilled in the art "would provide a list of commonly used triggers to allow a user to quickly configure their device with an initial set of triggers" (*See* Final Office Action, p.4). In other words, the Examiner appears to take the position that the ability to configure an incredibly unique trigger would lead one skilled in the art to provide a list of commonly used status items. However, a close reading of both references fails to locate any support whatsoever for this theory. The ability to configure and customize a trigger says nothing about specifying which status information to send to each of the other group members by choosing a status item from a list of available status items. Upon what evidence of record, then, does the Examiner base this theory? Indeed, neither Borgstahl nor Rosenberg mention anything about choosing a status item from a list of available status items, and the Examiner never asserts that they do. Instead, the Examiner simply

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makes a leap in logic based on nothing more than speculation and unsupported facts. This is improper under the law governing §103. Therefore, contrary to the Examiner's assertions, neither Borgstahl nor Rosenberg teach or suggest, alone or in combination, claim 4.

Group 4

Claim 5, a Group 4 claim, depends directly from claim 2 and indirectly from claim 1. Claim 5 requires designating a period during which status updates are enabled. For reference, claim 5 appears below.

> 5. The communication method according to claim 2 further including the step of designating a period during which status updates are enabled.

Thus, each individual member of the group can specify particular time periods during which status updates will be sent to each of the other members in the group. For example, one member of the group may choose to update each of the other members in work-related affinity group only during business hours.

For the reasons stated above, Borgstahl and Rosenberg, alone or in combination, fail to teach or suggest both claims 1 and 2. Thus, claim 5 is also patentably non-obvious over the cited art, and the §103 rejection of claim 5 is improper.

Further, the Examiner asserts in his rejection that Borgstahl teaches claim 5 because Borgstahl discloses, "providing updates if/when two users are proximate, based on a schedule or triggered upon the expiration of a fixed or random timer." This assertion, however, is wholly inaccurate. Borgstahl does not teach specifying a time period during which status updates are enabled, but instead, discloses that a peer may periodically seek to establish a connection with another peer based upon a time schedule (e.g., every few seconds) or the expiration of a timer. This teaches nothing more than a periodic "polling" interval in which one peer can seek out a connection with

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another every so often. This method is necessary in Borgstahl because the connections are dynamic and the peers must be in close geographical proximity to one another in order to establish a connection. Plainly, configuring a device to blindly poll every few seconds does not teach or even suggest configuring a device to send status updates to each of the other members in the affinity group only during a specified time period, for example, between the hours of 8:00 a.m. and 5:00 p.m. Accordingly, neither Borgstahl nor Rosenberg teach or suggest, alone or in combination, the subject matter of claim 5.

Group 5

Claim 6, a Group 5 claim, depends directly from claim 2 and indirectly from claim 1. Claim 6 explicitly requires designating a period during which status updates are suppressed. For reference, claim 6 appears below.

> 6. The communication method according to claim 2 further including the step of designating a period during which status updates are suppressed.

Thus, each individual group member can also specify periods of time in which status reporting is suppressed. For example, a member may wish to suppress status reporting to a work-related affinity group after business hours are over.

The §103 rejection to claim 6 fails because the art cited by the Examiner does not teach or suggest, alone or in combination, claims 1 and 2. Therefore, the cited art necessarily fails to teach or suggest, alone or in combination, claim 6. Accordingly, the §103 rejection of claim 6 is improper.

Further, the Examiner states in his rejection that Borgstahl teaches restricting access to the peer through the network, and that one facet of Borgstahl is a point-of-sale capability requiring "an extensive authorization process." The Examiner further theorizes that this teaching, coupled with the periodic scheduling (see remarks with respect to claim 5 above) would lead one skilled in the art to provide "the step of designating a

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period during which status updates are suppressed." Applicant, however, is perplexed as to how authentication of a device in a point-of-sale application of Borgstahl, with or without periodic polling, teaches or suggests designating a period during which status updates are suppressed. The periodic polling disclosed by Borgstahl merely seeks to establish a connection with an *unknown* (i.e., possible) peer every so often (e.g., every 3 seconds), and the authentication procedures, extensive or otherwise, simply protect against unauthorized access. Whatever Borgstahl teaches about authentication processes, it teaches absolutely nothing about designating time periods, and certainly teaches nothing regarding designating a time period when status update messages are suppressed.

The Examiner's reasoning simply does not pass scrutiny and cannot be relied upon to show that the cited art, alone or in combination, teaches or suggests claim 6. Again, the Examiner has rejected a claim based on mere speculation and unsupported facts, and as stated above, this is incorrect as a matter of law. Borgstahl never indicates that a user may define periods during which status update messages to each other member of the group are suppressed, for example, between the hours of 5:00 p.m. and 8:00 a.m. In fact, Borgstahl never even teaches a status message. Therefore, the art cited by the Examiner also fails to teach or suggest, alone or in combination, claim 6.

Group 6

Claim 10, the independent claim of Group 6, relates to a method implemented in a mobile communications network that permits affinity group members to send/receive status information to/from each of the other members in the affinity group. For reference, claim 10 appears below.

10. A communication method implemented in a mobile communication network for allowing members of an affinity group to send status information to and receive status information from other members of said affinity group, said communication method comprising:

a. forming an affinity group containing two or more members;

b. storing member status information data in each mobile communication device used by said members;

c. sending a first status update message from a first member's communication device to a centralized server when said first member's status changes;

d. forwarding said first status update message from said server to each other member of said affinity group, including a second member of said affinity group;

e. receiving said status update message at said second member's mobile communication device and updating said status information in said second member's mobile communication device when said status update message is received;

f. sending a second status update message from said second member's communication device to said centralized server when said second member's status changes;

g. forwarding said second status update message from said server to each other member of said affinity group, including said first member of said affinity group;

h. receiving said status update message at said first member's mobile communication device and updating said status information in said first member's mobile communication device when said second status update message is received.

The reciprocity of claim 1 is more explicitly called out in claim 10. Specifically, claim 10 requires "sending a first status update message from a first member's communication device to a centralized server when said first member's status changes...forwarding said first status update message from said server to each other member of said affinity group, including a second member of said affinity group...sending a second status update message from said second member's communication device to said centralized server when said second member's status changes...[and]...forwarding said second status update message from said server to each other member of said affinity group, including said first member of said affinity group." In other words, neither members A nor B are ignorant of the others' status, as status message updates are bilateral. Accordingly, the general logic of the arguments

expressed above with respect to claim 1 also apply to claim 10, but are further elaborated on below.

The Examiner theorizes that since Borgstahl and Rosenberg both disclose networks containing multiple users, "it would inherently allow for an affinity group member to send, receive, forward and store member information for each/all users." However, this assertion is incorrect and wholly unsupported by the references themselves. As stated above with respect to claim 1, the subscriber will be notified when the status of the publisher changes, but the publisher is completely ignorant of the status changes of the subscriber. The notification process with respect to Rosenberg occurs only from the publisher to the subscriber, never the other way around, and certainly never between subscribers. Merely because a reference teaches a network having multiple users says nothing about how that network operates, especially with respect to sending status update messages between users. It simply means that a communications network can have more than one user (which, Applicant notes, is true of most communications networks).

Moreover, there is nothing in either reference that teaches, or even suggests, "storing member status information data in each mobile communication device used by said members." As stated above, the Examiner merely assumes that the memory disclosed by Borgstahl can be used to store the status information of each of the other group members. However, the memory of Borgstahl actually stores executable programs, personalization data, and application data (e.g., ID Codes, PINs, channel presets, etc.). None of the data disclosed by Borgstahl and stored in memory has anything to do with the status information of the member associated with the device, let alone the status information of _any_ of the other group members.

Further, the Examiner proffers the same _legally insufficient_ motivation to combine the cited art as recited in claim 1. Thus, the motivation to combine fails for the same

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reasons as those stated above with respect to claim 1. Accordingly, neither Borgstahl

nor Rosenberg teach or suggest, alone or in combination, claim 10.

Group 7

Claim 19, the independent claim of Group 7, recites a mobile communications

device used in the methods of claims 1 and 10. For reference, claim 19 appears below.

> 19. A mobile communication device for allowing a member of an affinity
> group to send status information to and receive status information from
> other members of said affinity group, said mobile communication device
> comprising:
> a. a memory for storing member status information data;
> b. a transmitter for transmitting status update messages to other
> members of said affinity group when said member's status changes;
> c. a receiver for receiving status update messages from other members of
> said affinity group;
> d. a processor operatively connected to said memory for writing status
> information to and reading status information from said memory, said
> processor being programmed to:
> 1. generate a status update message when said member's status
> changes for transmission by said transmitter to each other member
> of said affinity group; and
> 2. update said status information stored in said memory when a status
> update message is received from another member of said affinity
> group.

Claim 19 specifically requires "a processor operatively connected to said memory for

writing status information to and reading status information from said memory, [and]

programmed to...generate a status update message when said member's status

changes for transmission by said transmitter to each other member of said affinity

group...[and]...update said status information stored in said memory when a status

update message is received from another member of said affinity group."

The Examiner rejected claim 19 for substantially the same reasons as those

recited for claim 1. However, as pointed out above, neither Borgstahl nor Rosenberg,

alone or in combination, teach or suggest claim 1. Therefore, for reasons similar to

those discussed above with respect to method claim 1, both Borgstahl and Rosenberg, alone or in combination, fail to teach or suggest apparatus claim 19.

Group 8

Claim 20 depends directly from claim 19, and further defines the claimed memory to store member status including information a plurality of status items. For reference, claim 20 appears below.

> 20. The mobile communication device according to claim 19 wherein the member status information stored in said memory includes a plurality of status items.

As neither Borgstahl nor Rosenberg teach or suggest, alone or in combination, claim 19, they necessarily fail to teach or suggest, alone or in combination, claim 20. Thus, the §103 rejection to claim 20 is improper.

Further, the Examiner rejects claim 20 asserting the same reasons and support for the rejection as given for claim 2. However, as stated above with respect to claim 2, neither Borgstahl nor Rosenberg teach or suggest, alone or in combination, memory that stores status information that includes a plurality of status items. Thus, for the additional reasons discussed above with respect to claim 2, the cited art fails to teach or suggest, alone or in combination, claim 20.

Group 9

Claim 22 depends directly from claim 19, and further requires a means for selecting the status items from a list of available items that are reported to each of the other members of the affinity group. For reference, claim 22 appears below.

> 22. The mobile communication device according to claim 19 further including means for selecting the status items from a list of available status items that are reported to each other member of the affinity group.

Claim 22 is patentably non-obvious over the art cited by the Examiner because it depends from claim 19. As stated above, neither reference teaches or suggests, alone or in combination, claim 19; and, as such, the §103 rejection to claim 22 is improper.

Further, the Examiner rejects claim 22 citing the same reasons as those given for claim 4. However, as stated above, Rosenberg teaches only a subscriber configuring a trigger, not both the publisher and the subscriber (i.e., each member of the affinity group). Certainly, Rosenberg fails to teach or suggest that both the publisher and the subscriber select items from a list of available items that are reported to each of the other members in the group (i.e., reciprocity). Thus, for the additional reasons discussed above with respect to claim 4, neither Borgstahl nor Rosenberg teaches or suggest, alone or in combination, claim 22.

Group 10

Claim 23 depends directly from claim 19, and further requires a means for designating a period during which status updates are enabled. For reference, claim 23 appears below.

> 23. The mobile communication device according to claim 19 further including means for designating a period during which status updates are enabled.

As neither reference teaches or suggests, alone or in combination, claim 19, they necessarily fail to teach or suggest, alone or in combination, its dependent claim 23. Therefore, the rejection of claim 23 is improper. Additionally, as stated above with respect to claim 5, neither reference teaches or suggests designating a time period in which status update messages are enabled. Thus, for reasons similar to those given in claim 5, Borgstahl and Rosenberg fail to teach or suggest, alone or in combination, claim 23.

Group 11

Finally, claim 24 depends directly from claim 19 and requires a means for designating a time period in which the status update messages are suppressed. For reference, claim 24 appears below.

> 24. The mobile communication device according to claim 19 further including means for designating a period during which status updates are suppressed.

As both Borgstahl and Rosenberg fail to teach or suggest, alone or in combination, claim 19, they necessarily fail to teach or suggest, alone or in combination, claim 24. Thus, claim 24 is patentably non-obvious over the cited art and the §103 rejection of claim 24 is improper.

Further, as stated above with respect to claim 6, neither reference teaches or suggests designating a time period in which status update messages are suppressed. Therefore, for the additional reasons discussed above with respect to claim 6, both Borgstahl and Rosenberg fail to teach or suggest, alone or in combination, claim 24.

Summary of Argument

The Examiner has categorically failed to establish a legally sufficient *prima facie* case of obviousness. Not only do the references fail to teach each element of the claims, but also, the motivation to combine the references falls far short of the *legally sufficient* reasoning required by law. These reasons are enough to warrant the reversal of the §103 rejections leveled by the Examiner.

Conclusion

For the reasons set forth above, all claims being appealed herein are patentable,

and the rejections maintained by the Examiner must be reversed.

Respectfully submitted,

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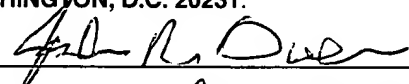Registration No. 42,055
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(9) APPENDIX

Claims

1. A communication method implemented in a communication network for allowing members of an affinity group to send status information to and receive status information from other members of said affinity group, said communication method comprising:

   a. forming an affinity group containing two or more members;

   b. storing, in each individual members' communication device, status information concerning each other member of said affinity group;

   c. when the status of any member in said affinity group changes, sending a status update message from said member whose status has changed to said each other member of said affinity group;

   d. receiving said status update messages concerning each other member of said affinity group at said each other member's communication device; and

   e. updating said status information in said each other member's communication device when a status update message concerning said any member is received.

2. The communication method according to claim 1 wherein said status information comprises a plurality of status items.

3. The communication method according to claim 2 wherein the status information includes at least one or more of the following status items: on/off status of the member; activity status of the member; and location of the member.

4. The communication method according to claim 2 wherein each individual member selects the status items from a list of available status items that are reported to each other member of the affinity group.

5. The communication method according to claim 2 further including the step of designating a period during which status updates are enabled.

6. The communication method according to claim 2 further including the step of designating a period during which status updates are suppressed.

7. The communication method according to claim 1 further including the step of automatically detecting status changes of a member and sending status update messages to said each other member of said affinity group when a status change is detected.

8. The communication method according to claim 7 wherein the status of a member is monitored by said member's communication device and wherein said communication device is programmed to automatically transmit a status update message to said each other member of said affinity group when a change in status is detected.

10. A communication method implemented in a mobile communication network for allowing members of an affinity group to send status information to and receive status information from other members of said affinity group, said communication method comprising:

   a. forming an affinity group containing two or more members;

   b. storing member status information data in each mobile communication device used by said members;

   c. sending a first status update message from a first member's communication device to a centralized server when said first member's status changes;

   d. forwarding said first status update message from said server to each other member of said affinity group, including a second member of said affinity group;

   e. receiving said status update message at said second member's mobile communication device and updating said status information in said second member's mobile communication device when said status update message is received;

   f. sending a second status update message from said second member's communication device to said centralized server when said second member's status changes;

   g. forwarding said second status update message from said server to each other member of said affinity group, including said first member of said affinity group;

   h. receiving said status update message at said first member's mobile communication device and updating said status information in said first member's mobile communication device when said second status update message is received.

11. The communication method according to claim 10 wherein said status information comprises a plurality of status items.

12. The communication method according to claim 11 wherein the status information includes at least one or more of the following status items: on/off status of the member; activity status of the member; and location of the member.

13. The communication method according to claim 11 wherein each individual member selects the status items from a list of available status items that are reported to each other members of the affinity group.

14. The communication method according to claim 11 further including the step of designating a period during which status updates are enabled.

15. The communication method according to claim 11 further including the step of designating a period during which status updates are suppressed.

16. The communication method according to claim 10 further including the step of automatically detecting status changes of a member and sending status update messages to said each other member of said affinity group when a status change is detected.

17. The communication method according to claim 16 wherein the status of a member is monitored by said member's communication device and wherein said communication

20. The mobile communication device according to claim 19 wherein the member status information stored in said memory includes a plurality of status items.

21. The mobile communication device according to claim 20 wherein the status items include one or more of the following status items: on/off status of the member; activity status of the member; and location of the member.

22. The mobile communication device according to claim 19 further including means for selecting the status items from a list of available status items that are reported to each other member of the affinity group.

23. The mobile communication device according to claim 19 further including means for designating a period during which status updates are enabled.

24. The mobile communication device according to claim 19 further including means for designating a period during which status updates are suppressed.

25. The mobile communication device according to claim 19 further including means for automatically detecting status changes of a member and sending status update messages to said each other member of said affinity group when a status change is detected.

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